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EXAMINER

SANDERS, STEPHEN

ART UNIT

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2434

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

This office action has been issued in response to Amendments to the specification, claims, and Remarks filed on March 16, 2009. Claims 1, 2, 4-6, 8-15, and 18-24 are currently pending, in which claims 1, 5-6, and 8-9 are in independent form.

Status of Claims:

Claims 1, 2, 4-6, 8-15, and 19-24 are rejected under 35 U.S.C. 102(b).

Claim 18 is rejected under 35 U.S.C. 103(a).

Accordingly, this action has been made FINAL.

Response to Amendment

Applicant's amendments to the Claims have been received and entered, in which claims 1, 5, 6, 8, and 9 are amended, and claims 18-24 have been added. In light of the amendments to the specification, the respective objection to the specification is withdrawn.

Response to Arguments

Applicant argues that the unique identifier obtained by Schwartz from the contents of the CD and based on the structural arrangement of the data (e.g. songs) is not sufficient for authenticating the "ownership", or original and legal producer of the CD. Applicant continues and states that their invention therefore is patentable over Schwartz and Valente. Examiner respectfully disagrees. Schwartz discloses (Abstract) "a method for authenticating that a specified prerecorded media, such as a CD, is in the possession of a user...". Those skilled in the art will acknowledge that the authentication is for the purpose of verifying the ownership, or legal producer of the CD.

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The comparison of the unique identifier obtained by Schwartz based on the structural arrangement of the data (e.g. songs) is for the purpose of determining whether the CD is the correct “album”, such as the CD entitled "Human Clay" by the band Creed (Schwartz: page 1, lines 20-22). Schwartz further discloses on page 14, that "Those skilled in the art will appreciate that although these are examples of multimedia data, other types of corresponding data other than multimedia (e.g., program codes, encrypted data, etc.) may also be utilized in accordance with a preferred embodiment of the present invention” – for example, for further authenticating the CD for verification of song content, or legal authority, etc. Schwartz (page 14) also adds that “various changes in form and detail may be made therein without departing from the spirit and scope of the invention”. Based on this, Examiner disagrees with Applicant’s arguments. As such, Applicant's arguments have been fully considered and are not persuasive. Applicant’s claim amendments have been entered. Accordingly, as stated above, the rejections remain and are shown below with respect to the amended claims.

35 USC § 112, 6th Paragraph

1. The following is a quotation of 35 U.S.C. 112, 6th Paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

2. The language of multiple elements within independent claim 6 recited the means-plus-function language and invoked 35 U.S.C. 112, sixth paragraph. These claim elements of independent claim 6 contain the “means for” phrase, and are modified by

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the following functional language respectively: “retrieving memory medium properties ...”; “authenticating said memory medium ...”; and “blacklisting the device ...”.

Additionally, they are not modified by sufficient structure and thereby are being treated under 35 U.S.C. 112, sixth paragraph.

3. No other claims and/or claim elements invoke 35 U.S.C. 112, sixth paragraph.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-6, 8-15, and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz.

As to claim 1, the following is taught: “A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before

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sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to claim 2, the following is taught: “The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium.” (Schwartz teaches: Abstract, Detailed Description of the Preferred Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 4, the following is taught: “The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties.” (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page 16).

As to claim 5, the following is taught: “A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory

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medium inserted in the device, to authenticate said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and to determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to claim 6, the following is taught: “A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium, means for retrieving memory medium properties from the memory medium inserted in the device, means for authenticating said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and means for determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description

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of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments).

As to claim 8, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, and determining that the memory medium is illegally produced when the memory medium properties are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5 line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to claim 9, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for

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the memory medium, said communication method comprising the acts of: retrieving memory medium properties from the memory medium inserted in the device, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to claim 10, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 19, the following is taught: "The communication method of claim 1, wherein the memory medium properties includes a region code of the memory medium" (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 20, the following is taught: "The communication method of claim 19, wherein the additional data includes advertisement depending on the region code" (Schwartz: Abstract; page 1, lines 15-16; page 1, line 19 to page 2, line 17; page 13, lines 22-31; page 14 line 23 to page 15 line 2).

As to claim 21, the following is taught: "The communication method of claim 1, further comprising the act of allowing recording of the additional data if the authenticating act is successful" (Schwartz: Abstract; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21).

As to claim 22, the following is taught: "The communication method of claim 1, further comprising the act of allowing access to the additional data only while the memory medium is being played in the device" (Schwartz: Abstract; page 1, line 19 to page 2, line 17; page 5, lines 20-27; page 12, line 16).

As to claim 23, the following is taught: "The communication system of claim 5, wherein the memory medium properties includes a region code of the memory medium,

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and the additional data includes advertisement depending on the region code”

(Schwartz: Abstract; page 1, lines 15-16; page 1, line 19 to page 2, line 17; page 13, lines 22-31; page 14 lines 3-13, line 23 to page 15 line 2).

As to claim 24, the following is taught: “The remote unit of claim 6, wherein the memory medium properties includes a region code of the memory medium, and the additional data includes advertisement depending on the region code” (Schwartz: Abstract; page 1, lines 15-16; page 1, line 19 to page 2, line 17; page 13, lines 22-31; page 14 lines 3-13, line 23 to page 15 line 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Valente et al (U.S. Publication Number 2003/0110192 A1), hereinafter Valente.

As to claim 18, the following is taught: “The communication method of claim 1 (See claim 1 above).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 18, but fails to teach: “blacklisting the device if the remote unit

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receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium". However, Valente teaches blacklisting a device after it exceeds a number of attempts of "illegal" operations and renders device incapable of conducting further activities (Valente: page 6, paragraph [0070]). In view of Valente's teachings regarding blacklisting techniques, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include blacklisting techniques in determining device authentication. Although these specifics are not recited by Schwartz, one would be motivated to use any and all blacklisting techniques in order to provide for better and faster authentication management.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN SANDERS whose telephone number is (571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434